

REMARKS

1. In the above-captioned Office Action, the Examiner rejected claims 1, 4, 6, 7, and 19 under 35 U.S.C. §102(b) in view of Inciong (U.S. Patent No. 6,543,787). Claims 1-18 were rejected under 35 U.S.C. §103(a) given Belter (U.S. Patent No. 5,168,047) in view of Inciong. These rejections are traversed and reconsideration is hereby respectfully requested.

2. Claims 1, 4, 6, 7, and 19 were rejected under 35 U.S.C. §102(b) in view of Inciong. Claims 1-18 were rejected under 35 U.S.C. §103(a) given Belter in view of Inciong.

The Examiner states that Inciong discloses a gasket comprising a metal substrate disposed along an outer perimeter of the gasket, and that there is an elastomeric bead (32) disposed along at least an interior perimeter of the metal substrate. According to the Examiner, there is an elastomeric ring (32, around 22 that is in the form of a ring) disposed along the metal substrate *having an inner diameter*.

According to FIG. 2 of Inciong, the elastomeric ring (32, around opening 22 that is in the form of a ring) is disposed around and outside an inner diameter of the opening 22. The inner diameter around the opening 22 is metal and is not formed wholly or in part by the elastomeric ring 32, which has an inner diameter that is larger than the inner diameter of the opening 22. In other words, the elastomer does not reach the opening 22, and thus is incapable of touching a fastener disposed in the opening 22.

Therefore, the gasket of Inciong cannot be used to retain a fastener. Any fastener in opening 22 of Inciong would be retained by the metal, not the elastomer. Placing and/or retaining a fastener in opening 22 is beyond the teachings of Inciong because Inciong clearly teaches that opening 22 is designed for a dipstick, not a fastener, as set forth in column 3, lines 3-6. Inciong does not teach or suggest retaining fasteners with an elastomeric ring of a gasket.

If Inciong's elastomeric ring had *an inner diameter that is smaller than an outer diameter of a fastener* as set forth in independent claims 1, 8, and 13, then insertion of the fastener in opening 22 would result in the metal substrate, not the elastomeric ring as claimed, retaining the fastener, and would result in deformation of the metal substrate. Further, Inciong makes no teaching or suggestion that his of any such retaining mechanisms or intent of retention.

Inclong makes no statement, nor shows in the drawings, that the inner diameter of the waffle pattern region 32 surrounding the opening 22 is either larger or smaller than a fastener, and even if the opening was smaller than the fastener, Inclong's elastomer would be inoperable as a retention device for a fastener.

Moreover, neither Inclong nor Belter teaches numerous other elements (e.g., teeth, a second elastomeric ring) of Independent claim 13, which will not be set forth in further detail for the sake of brevity.

With respect to dependent claims 6, 10, and 16, neither Inclong nor Belter teaches or suggests that when the fastener is inserted through the fastener hole and the elastomeric ring, the gasket and fastener are sufficiently attached to the flange to permit installation of the fastener without the gasket and fastener falling off the flange. Neither of these references teaches or suggests this element and moreover, this element would be impossible to achieve with the teachings of Inclong and/or Belter. With respect to claims 19 and 20, neither Inclong nor Belter teaches or suggests an interference fit.

Neither Inclong nor Belter teaches or suggests that *the inner diameter of the elastomeric ring is smaller than an inner diameter of an opening formed in the metal substrate into which opening the elastomeric ring extends*, as set forth in dependent claim 12 as amended above, nor that *the elastomeric ring extends radially inwardly of an opening in the metal substrate*, as set forth in dependent claim 18 as amended above.

Thus, Inclong fails to teach at least one element in each of the independent claims, as well as other elements in the dependent claims, and Inclong fails to teach the subject matter of claims 1-20. Belter also fails to make such teachings.

Thus, the claims of the present invention are not taught or suggested by Inclong and/or Belter. Combining these references fails to teach or yield the invention as claimed. The combination of these references fails to teach or suggest all the elements of the claims. Further, one of skill in the art would not be motivated to make such a combination. Therefore, the present invention is not obvious in light of any combination of Inclong and/or Belter.

Furthermore, claims 2-7, 9-12, and 14-20 are dependent upon an Independent claim that is shown to be allowable. For all these reasons, the dependent claims are themselves allowable.

The Examiner argues that the above elements that are shown to be patentably distinct over the references are not positively claimed. The Examiner has set forth no support in the MPEP for this contention. The limitations of the claims that are shown above to be distinct over the references of record would be held to be limiting by a court. Nevertheless, claim 5 is amended above in an attempt to advance the prosecution.

Hence, the applicant respectfully submits that claims 1-20 may be passed to allowance.

3. The above amendment and response is necessary because it places the application in condition for allowance and was not previously entered because the current Examiner first brought the grounds of rejection in the Final Office Action. After providing the previous amendment and response to the prior Examiner, the Applicant's attorney discussed the amendment and response with the prior Examiner by telephone, and the prior Examiner agreed to remove the rejections. By telephone, the current Examiner indicated that he was not aware of the prior Examiner's agreement, stated that he would not abide by the prior Examiner's agreement, thus necessitating this response.

4. The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication may advance the prosecution of the present application. Notice of allowance of claims 1-20 is hereby respectfully requested.

Respectfully submitted,

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